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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,784	01/12/2001	Cary Lee Bates	ROC920000007US2	9669

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EXAMINER

D AGOSTA, STEPHEN M

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 01/20/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,784

Applicant(s)

BATES ET AL.

Examiner

Stephen M. D'Agosta

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 12-19-03 have been fully considered but they are not persuasive:

1. The applicant argues that Jonsson does not teach "automatically ringing the second phone without requiring input from the user of the portable phone". The examiner disagrees - Upon closer inspection the applicant's system can only operate with a second phone which allows for automatic ringing of said second phone since no other phones are involved (eg. there is no other phone to select from). Jonsson, on the other hand, can select from more than just a second phone (eg. multiple phones) and therefore allows the user to select the best phone. If Jonsson's invention were placed in a situation where there is only one other phone (eg. the second phone), the system would only be capable of ringing the second phone which would be automated.

While automating a manual function is not intrinsically novel [Refer to *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) - The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art], new prior art is provided which addresses this limitation (Andrew US 5,502,762 teaches a phone system (automatically) redirecting an incoming call for a first line to a selected one or more second lines (abstract)).

2. The applicant argues the rejection of claims 3, 8-9 and 16-17 is not proper based on how many phones can be rung AND selecting which phone to answer. The examiner disagrees. Firstly, Jonsson has the ability to identify multiple phones near the user. It is obvious that a user can only operate one phone at a time so ringing multiple phones appears to be a non-necessity (although Mukerjee teaches ringing multiple phones). Hence Jonsson can ring one phone while Mukerjee can ring multiple phones whereby the combination provides for ringing at least one (or more) phone. Secondly, if a user is in a hallway when a call is received and wants to transfer the call, they may not know where each nearby phone is and will want to ring multiple phones and select the closest one (which provides motivation for ringing multiple phones and selecting which one to answer).

3. The applicant argues the rejection for claims 4 and 12 is not proper since it only teaches one phone being rung. The examiner disagrees and notes that the invention is based on a "group of mobiles" which are known to the telecommunication system as a "common group address" (abstract). One skilled in the art realizes that talk groups exist and have the ability of ringing multiple phones. DeBrito discloses the ability of "at least one phone being rung when Subscriber-A calls B-Subscribers (page 2, L1-5) which reads on ringing multiple phones. The fact that Jonsson's invention focuses on the ringing of only ONE phone is not indicative that the system cannot ring

Art Unit: 2683

multiple phones, but that the user is allowed to select ONE phone. As discussed in #1 above, if the user is located in a hallway and the phone numbers have locations unknown to the user, the user would choose to ring multiple/all phones and listen for the closest. It appears that both Jonsson and DeBrito improve prior inventions that only had the capability of ringing multiple phones (and hence migrated to being more exacting by attempting to select the ringing of just one phone which does NOT discount the system's ability of ringing multiple phones).

4. The applicant argues the rejection for claims 18 and 20-22 does not recite a call routing. The examiner disagrees since "call routing" is a broad term and hence the disclosure that "when a wireless unit inserted into a geographical sub-area, it inherits the attributes of that sub-area with respect to basic operations and features". The examiner interprets basic operations and features as reading on routing a call (eg. if a user roams into an area outside their home area, do not allow incoming/outgoing calls, etc.).

5. The applicant argues the rejection for claim 26 does not recite the claimed limitations for steps 1-5. The examiner disagrees since he must broadly interpret each claim presented. The "exact wording" is not the basis for novelty, it is the "system's description and functionality" that warrants its novelty. Hence, Schmitt's teaching of a method that can identify a region within a geographic coverage area of a BTS in a wireless network and interpolate the locations in said region to define a boundary reads on steps 1-5 and combines with Jonsson for a proper rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-6, 10 and 13-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson et al. US 5,903,833 and further in view of Andrew et al. US 5,502,762 (hereafter Jonsson and Andrew).

As per **claims 1 and 10**, Jonsson teaches a phone system comprising:

A portable phone that includes a position detector that detects the position of the portable phone

A second phone

A call router that rings the second phone when a call is received for the portable phone if the portable phone is within a predetermined physical relationship with the second phone as indicated by the position detector in the portable phone (abstract and figures 1-3)

But is silent on automated the router to ring the second line without input from the user.

Andrew teaches a phone system (automatically) redirecting an incoming call for a first line to a selected one or more second lines (abstract).

It would have been obvious to one skilled in the art at the time of the invention to modify Jonsson, such that the system automatically routes calls without user input, to provide an automated system that provides ease-of-use to the user so that they do not have to decide which phone to ring.

As per **claims 5 and 13**, Jonsson teaches claim 1/10 wherein the second phone comprises a land-based phone coupled to a telephone jack (figure 1, #22).

As per **claims 6 and 14**, Jonsson teaches claim 1/10 wherein the physical relationship comprises a predefined geographical region (abstract teaches low power registration devices that provide separate "coverage areas" which reads on the claim).

Claims 2 rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson and further in view of Dennison et al. US 5,235,633 (hereafter Dennison).

As per **claim 2**, Jonsson teaches claim 1 **but is silent on** the position detector comprises GPS sensor.

Dennison teaches cell phone system that uses position of the mobile unit to make call management decisions that uses GPS for position detection (abstract).

It would have been obvious to one skilled in the art at the time of the invention to modify Johsson, such that GPS is used, to provide worldwide location determination.

Claims 3, 8-9, 11 and 16-17 rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson and further in view of Mukerjee et al. US 6,405,041 (hereafter Mukerjee).

As per **claims 3 and 11**, Jonsson teaches claim 1/10 **but is silent on** wherein the call router rings the portable phone at the same time the call router rings the second phone and connects the call to whichever of the portable/second phone is answered first.

Jonsson teaches a manual user selection (via the mobile phone) as to which phone is to be used, not by picking up one of the ringing phones. This provides MORE detailed software/hardware design since the system can identify any/all phones (PLURAL) near the user and provide their location (C5, L49-51) as well as allowing the user to provide a preferred phone for the conversation (C12, L30-35). Hence the examiner interprets Jonsson as doing more than just ringing a second phone and providing a connection to whichever one is answered first, which reads on the claim.

Mukerjee teaches simultaneously ringing a subscriber's wired and wireless phones simultaneously (abstract) and that ringing occurs until either the wired or wireless unit answers the call (C5, L20-22).

It would have been obvious to one skilled in the art at the time of the invention to modify Johsson, such that both phones are rung until one is answered, to provide means for the user to select which phone they want to answer.

As per **claims 8 and 16**, Jonsson teaches claim 1 **but is silent on** wherein the call router further rings the portable phone when a call is received for the second phone if the portable phone is within the predetermined physical relationship with the second phone (C5, L4-60).

Jonsson teaches allowing the mobile or the fixed phone to receive or make a call based upon the mobile's phone number, the fixed phone number or the mobile using a newly assigned fixed phone number. This would provide for the mobile phone to ring if the second phone receives a call. Also reference C12, L44-54.

Mukerjee teaches simultaneously ringing a subscriber's wired and wireless phones simultaneously (abstract) and that ringing occurs until either the wired or wireless unit answers the call (C5, L20-22).

It would have been obvious to one skilled in the art at the time of the invention to modify Johsson, such that the mobile can be rung when the second phone has a call, to allow the user to choose to answer said call on the mobile phone.

As per **claims 9 and 17**, Jonsson teaches claim 8/16 **but is silent on** wherein the call router rings the portable phone at the same time the call router rings the second phone, and connects the call to whichever portable/second phone is answered first (Jonsson teaches a manual user selection (via the mobile phone) as to which phone is to be used, not by picking up one of the ringing phones. This provides MORE detailed software/hardware design since the system can identify any/all phones (PLURAL) near the user and provide their location (C5, L49-51) as well as allowing the user to provide a preferred phone for the conversation (C12, L30-35). Hence the examiner interprets Jonsson as doing more than just ringing a second phone and providing a connection to whichever one is answered first, which reads on the claim. Also reference C12, L44-54).

Mukerjee teaches simultaneously ringing a subscriber's wired and wireless phones simultaneously (abstract) and that ringing occurs until either the wired or wireless unit answers the call (C5, L20-22).

It would have been obvious to one skilled in the art at the time of the invention to modify Johsson, such that both phones are rung until one is answered, to provide means for the user to select which phone they want to use to answer the call.

Claims 4 and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson and further in view of DeBrito WO99/33199 (hereafter DeBrito).

As per **claims 4 and 12**, Jonsson teaches claim 1/10 **but is silent on** wherein the second phone comprises a portable phone.

DeBrito teaches ringing one or more mobile phones in a group of mobile units to which the called party number refers to (abstract).

It would have been obvious to one skilled in the art at the time of the invention to modify Jonsson, such that the second phone is a mobile phone, to provide flexibility with regard to which phone(s) can be used within this system.

Claims 7 and 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson and further in view of Syed et al. US 6,038,451 (hereafter Syed).

As per **claims 7 and 15**, Jonsson teaches claim 1/10 **but is silent on** wherein the physical relationship comprises a predefined distance between the portable phone and the second phone.

Syed teaches forwarding a call to a second (wired) phone if the mobile is located near the geographic location associated with the wired phone (abstract and figure 1).

It would have been obvious to one skilled in the art at the time of the invention to modify Jonsson, such that a predefined distance is used between the phones, to provide means for proximity to trigger ringing of phones as an alternate to just location.

Claims 18 and 20-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson and further in view of Hardouin EP0876071 (hereafter Hardouin).

As per **claim 18**, Jonsson teaches a phone system comprising:

A portable phone that includes a position detector that detects the position of the portable phone

A second phone

A call router that rings the second phone when a call is received for the portable phone if the portable phone is within a predetermined physical relationship with the

second phone as indicated by the position detector in the portable phone (abstract and figures 1-3)

But is silent on each geographic region having a phone parameter that determines how a call is rung and routing a call based on phone parameters for a region.

Hardouin teaches determination of a wireless handset's location and audio/vibration alerting based on location (abstract, "users may choose to specify areas designated by the system administrator for audio alerting or vibration alerting" and "the system administrator may determine different alerting information for different areas of the building").

With further regard to claim 22, Jonsson teaches entering a coverage area (which reads on determining entering/exiting from a defined geographical region) but is silent on updating phone parameters when exiting a region.

Again, Hardouin teaches determination of a wireless handset's location and audio/vibration alerting based on location (abstract, "users may choose to specify areas designated by the system administrator for audio alerting or vibration alerting" and "the system administrator may determine different alerting information for different areas of the building"). One skilled in the art would provide for updates as required while the user roams (ie. manually per the system administrator or automatically).

It would have been obvious to one skilled in the art at the time of the invention to modify Johsson, such that a phone parameter exists for different ringing/alerting, to provide means for the user to be alerted in different ways according to their location.

As per **claim 20**, Jonsson teaches claim 18 wherein and the mechanism (in C) reside in the portable phone (abstract teaches phone interacts with registration device) and the call router resides in the telephone company network (figure 1, #12 and #14) **but is silent on** the geographical region (in B).

Hardouin teaches a system level table (figures 4 and 5) that one skilled in the art would provide in the portable phone.

It would have been obvious to one skilled in the art at the time of the invention to modify Johsson, such that geographical location (information) is provided in the phone,

Art Unit: 2683

to provide storage means on the phone to allow it to determine its position without having to use valuable bandwidth to interrogate the BTS/BSC for said information.

As per **claim 21**, Jonsson teaches claim 18 the call router resides in the telephone company network (figure 1, #12 and #14) and the portable phone communicates its detected position to the call router (abstract) **but is silent on** wherein the at least one geographical region (in B), the mechanism (in C) reside in the phone network.

Hardouin teaches a system level table (figures 4 and 5) that resides in phone network (eg. BSC/BTS).

It would have been obvious to one skilled in the art at the time of the invention to modify Johsson, such that the region and mechanism reside in the network, to provide means for the various pieces to be moved to the network for flexibility/optimal operation.

Claim 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson and further in view of Dennison.

As per **claim 19**, Jonsson teaches claim 18 **but is silent on** the position detector comprises GPS sensor.

Dennison teaches cell phone system that uses position of the mobile unit to make call management decisions that uses GPS for position detection (abstract).

It would have been obvious to one skilled in the art at the time of the invention to modify Johsson, such that GPS is used, to provide worldwide coverage for location determination.

Claim 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson and further in view of Schmitt US 6,459,695 (hereafter Schmitt).

As per **claim 26**, Jonsson a portable phone and movement/roaming of the user (abstract and figures 1-3) **but is silent on** a method for dynamically defining a region for a portable phone that includes internal position detector, the method comprising:

1) placing the portable phone in dynamic region definition mode

Art Unit: 2683

- 2) moving the portable phone to a first boundary point
- 3) storing the first boundary point as a boundary point for a region as detected by the internal position detector
- 4) repeating steps 2 and 3 until all desired boundary points have been entered
- 5) computing a region by connecting the boundary points.

Schmitt teaches A method that can identify a region within a geographic coverage area of a base station in a wireless network and interpolate the locations in said region to define a boundary of said region (reference Schmitt's claim 1).

It would have been obvious to one skilled in the art at the time of the invention to modify Johsson, such that the region can be dynamically defined, to provide means for the user to have flexibility of how large a region they require to have the defined operational capabilities defined by Jonsson et al.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist on 703-306-0377.

SMD
1-7-04


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